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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,202	05/10/2006	Nathalie Vast	052737	7646
38834 7590 03/17/2010 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036				
EXAMINER DICUS, TAMRA				
ART UNIT 1794		PAPER NUMBER		
NOTIFICATION DATE 03/17/2010		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentmail@whda.com

# Office Action Summary

Application No.

10/541,202

Applicant(s)

VAST ET AL.

Examiner

TAMRA L. DICUS

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 4-10 and 13-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-3, 11 and 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

#### **DETAILED ACTION**

The art rejections over Fan are withdrawn.

The double patenting and 112 rejections are withdrawn.

All arguments are considered moot in view of the new ground of rejection below.

#### ***Election/Restrictions***

NOTE that while withdrawn claim 10 should be with claim 4 as the document is noted in claim 4, which is not in claim 1. Thus, the Examiner assumes that claim 10 should have been dependent upon claim 4, and not claim 1 and therefore, claim 10 is non-elected, and apart of group II as set forth in the restriction 06/23/09 and elected on 7/20/09.

Applicant's election with traverse of Group I, claims 1-3 and 10-12 in the reply filed on 07/20/09 is acknowledged. The traversal is on the ground(s) that claims 1 and 4 are related, claim 4 being dependent on claim 1 and that Fan does not teach the invention (namely the special technical feature, to thickness of miniregions as set forth in the claim 1). This is not found persuasive because the special technical feature (namely the two-sided printed indicia) is found in US 6,997,482 to Mathys et al. Applicants arguments to the 371 submission is acknowledged, as a lack of unity of invention and not restriction (arguing that the claims should be rejoined and examined), however,

Applicant has already elected one invention as indicated in the reply received 07/20/09 and the Examiner has explained why the inventions lack unity as the special

technical feature (the two-sided printed indicia and variation of lines and thickness of miniregions as recited) is disclosed by the applied prior art (see above).

Lack of unity of invention may be directly evident before considering the claims in relation to any prior art, or after taking the prior art into consideration, as where a document discovered during the search shows the invention claimed in a generic or linking claim lacks novelty or is clearly obvious, leaving two or more claims joined thereby without a common inventive concept. It has been established that the special technical feature is known and there is lack of unity, since the special technical feature, be it a single feature or a group of features, is not a technical feature that defines a contribution over the prior art. See MPEP 1806. Because this application contains the aforesaid inventions or groups of inventions which *are not* so linked as to form a *single* general inventive concept nor provide a contribution over the prior art (a printable security papery is different than a security document, which both are different to a method for producing a security document having the different shading of indicia as instantly recited in claims 8-9 and 14-20 (further a document is not in the paper of claim 1) and the prior art teaches the inventive concept, so the instant feature is not making a contribution over the prior art) under PCT Rule 13.1; in accordance with 37 CFR 1.499, applicant is required to elect a *single invention* to which the claims *must be restricted*. The restriction requirement under 35 U.S.C. 121 and 372 is FINAL.

*Claim Rejections - 35 USC § 102/103*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 11-12 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US 6,997,482 to Mathys.

Mathys teaches a two-sided paper with two sets of indicia (see 86, 88 patterned lines FIGs. 9A-9E, in perfect registration with each other, superimposed on each side of a document, includes paper, viewed in transmitted and reflected light, wherein the second set of lines on the back or reverse side can be seen in either light dependent upon the view of the observer, dependent upon if illuminated with a camera or during

photocopying to either see the control image (final image) wherein the observed first and second front and reverse sides contain indicia located in screened regions (backgrounds : front 85, back 87). See 4:30-68, 6:35, cols. 7-8 and patented claim 1. The spacing found between the paper and the indicia and between the indicia itself considered "vellum part" (see further 86 (thicker lines compared to 88) and 88 (thinner lines) of FIGs. 9A-9E, are and "vellum miniregions" and "miniregions", respectively). A constant thickness is also taught (89, FIG. 9C) and combined final image of print (see fine up and down arrows in Figs 9A-93). The medium for print is paper and may be a banknote (8:15-40), viewing in reflected and transmitted light to view whether or not the image can be checked to prevent counterfeiting . However, regarding "a region capable of receiving printed indicia", it is not germane since it has been held that an element that is "being able to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.

Moreover, while the opacity and spacing is not explicitly claimed as present to explicitly state the measurements and differences (claims 1-3 and 12), it is expected to be an inherent property. Alternatively, it would have been obvious to have used the Mathys spacing to produce a vellum region and miniregion, with the required opacity levels and thicknesses as the same or similar spacing and materials are provided. It

would have been obvious to one having ordinary skill in the art to have modified Mathys to use vellum miniregions and regions because Mathys teaches the spacing and variation of lines (includes thicknesses) affects the way the final image is viewed and thus detected for anti-counterfeiting measures. See again 7-8, especially 7:10-68 regarding thickness and spacing. See 5:1-20, 25-50 (regarding lines alternating to show image "K"). See 3:55-65 to color density varying and 4:35-68 to recto-verso printing (machine in col. 7-8), (the original title of the instant invention and thus having the same printed indicia).

Further note dependent upon not only the thickness of lines, but the color of ink, the opacity measurement is expected to change. It would have been obvious to one having ordinary skill in the art to make this assessment and reasonable to expect because indicia and paper carry different colors and thicknesses and thus different opacities are expected as taught by Mathys cited above. Further note: Though we are fully cognizant of the hindsight bias that often plagues determinations of obviousness, Graham v. John Deere Co., 383 U.S. 1, 36 (1966), we are also mindful that "the combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results," KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1739 (2007). Since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. Moreover, note It is submitted the optimal and/or claimed values of the respective material would have

been obvious to the skilled artisan at the time the invention is made since it has long being held that such discovery, such as an optimum value of the respective result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272,205 USPQ 215(CCPA 1980). See also MPEP § 2144.05 II (B).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAMRA L. DICUS whose telephone number is (571)272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Ruthkosky can be reached on 571-272-1291. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Ruthkosky/  
Supervisory Patent Examiner, Art Unit 1794

Tamra L. Dicus  
Examiner  
Art Unit 1794